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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,789	09/15/2003	Thomas E. Chefalas	YOR920010714US1	9514

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EXAMINER
VEILLARD, JACQUES

ART UNIT	PAPER NUMBER
2165	

NOTIFICATION DATE	DELIVERY MODE
01/09/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeeiplaw.com

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 November 2008*.
2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-10,14-17 and 19-25* is/are pending in the application.
　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1, 3-10, 14-17, 19-25* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
　　a)☐ All　b)☐ Some * c)☐ None of:
　　　1.☐ Certified copies of the priority documents have been received.
　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.
　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to the Applicant's communication filed on 11/07/2008.

2.   Claims 1, 8, 9, 10, 17 have been amended, and claims 2, 11-13, 18 canceled.

3.   Claims 1, 3-10, 14-17, 19-25 are pending and presented for examination.

Continued Examination Under 37 CFR 1.114

4.   A request for continued examination under 37 CFR 1. 1 14, including the fee set forth in

37 CFR 1. 1 7(e), was filed in this application after the Final Office Action. Since this application

is eligible for continued examination under 37 CFR 1. 1 14, and the fee set forth in 37 CFR 1.

17(e) has been timely paid, the finality of the previous Office action has been withdrawn

pursuant to 37 CFR 1. 1 14. Applicant's submission filed on November 07, 2008 has been

entered.

Amendment to the Specification

5.   Although Applicant's amendment to the specification appears to overcome the 101

rejection, however, alone the removal/deletion of subject matter in the specification is not

sufficient on its own and should be accompanied by a **DISAVOWAL STATEMENT** on

Applicant's remarks for the record. Therefore, the rejection of claim 8 under 35 USC 101

sustained as illustrated below.

Claim Rejections - 35 USC § 101

6.   35 U.S.C. 101 reads as follows:

>Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7.   Claims 1, 3-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims (or at least independent claim 1) are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class or do not change or switch statutory class (such as a particular apparatus) or do not transform the underlying subject matter (such as an article or materials) to a different state or thing. Therefore, the claims are related to mental processes, which are not patentable, and can be preformed without the use of a particular apparatus. Thus, claims 1, 3-7 are non-statutory and rejected under 35 USC § 101 since they may be performed within the human mind.

8.   Claims 10, 14-16 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

As per claim10, a "system" made up of two means is being cited. However, it appears

that one of ordinary skill in the art could interpret the system as software, per se. As define in the

specification, it is clear that each of the means is a software instruction to be executed, thus

constitutes functional descriptive material. When recorded on some computer-readable medium

it becomes structurally and functionally interrelated to the medium and will be statutory in most

cases since use of technology permits the function of the descriptive material to be realized.

However, the claim as written is not being embodied in a computer readable medium. Such as,

claim 10 is not limited to a statutory subject matter and is therefore non-statutory under 35

U.S.C. 101.

The other dependent claims 14-16 included in the statement of rejection but not

specifically addressed in the body of the rejection have inherited the deficiencies of their parent

claim and have not resolved the deficiencies. Therefore, they are rejected based on the same

rationale as applied to their parent claims above.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or
> described as set forth in section 102 of this title, if the differences between the subject
> matter sought to be patented and the prior art are such that the subject matter as a whole
> would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10.   Claims 1, 3-10, 14-17, and 19-25 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Howard et al. (U. S. Pat. No. 6,185,574) in view of Peltonen et al. U. S. Pat.

No. 5,926,807).

As per claims 1, 8, 10, and 17, Howard et al. disclose a system, which including data

processing system for locating files in a hierarchical directories as detailed in col.10, lines 10-

12, col.12, lines 27-34, col.12, line 66 through col.14, line 6). In particular, Howard et al.

disclose the claimed limitations wherein an input has been received indicating that a file is to be

saved (See Howard et al. Fig.15 in conjunction with steps 754 and 758, col.31, lines 18-23).

Howard et al. specifically disclose that a user can retrieve a file where the file is saved as

detailed in col.4, lines 55-57, col.12, and lines 16-27); receiving a request from a requester for

files associated with the unique identifier; responsive to the request, querying the data store for

an identification of the files associated with the unique identifier; receiving a result from the

data store; returning the result to the requester; receiving a selection of a file from the requester;

and responsive to the selection of the file, returning the file to an appropriate application (e.g.,

Howard et al. show in Fig.17 a possible record structure that the virtual directory system may

implement to provide the services that are expected by the native file system. By example, when

a user "a requester" does request access to a file that they have selected from the virtual

directory system from the virtual directory system the virtual directory system may return a file

handle in response to the file open command, … Once the file handle is returned, the virtual

directory system and the interceptor may then become a pass through device between the

physical storage device and the various requests of the user) as detailed (See Howard et al.

col.16, lines 28-45).   It is noted, however, Howard et al. did not specifically disclose the system

for saving the file in association with a unique identifier in a data store, responsive to receiving

an input, wherein the data store describes associations between files and unique identifiers and

wherein files are retrieved based on unique identifiers. On the other hand, Peltonen et al.

disclose a system for effectively representing query result in a memory where files have been

saved or stored (See Peltonen et al. Title and abstract, col.2, lines 55-67). In particular, Peltonen

et al. achieved the claimed limitations of, saving the file in association with a unique identifier

in a data store, responsive to receiving an input, wherein the data store describes associations

between files and unique identifiers and wherein files are retrieved based on unique identifiers,

by providing a bookmark associated with files as a unique identifier to identify files (See

Peltonen et al. Abstract lines 14-19, col.9, lines 25-67, col.11, lines 16-39).

It would have been obvious to one of ordinary skill in the art at the time of applicant's

invention was made to modify the parallel virtual directory system of Howard et al. by

incorporating the bookmark mechanism taught by Peltonen et al. because that would have

enhanced the system of Howard et al. by allowing it to retrieve files or documents store in data

store when a request to access to a file that they have selected from the virtual directory quickly

and efficiently using the bookmark as a unique identifier and return the result appropriately in

response to a request (See Peltonen et al. Abstract lines 14-19, col.8, lines 1-6).

As per claim 9, most of the limitations of this claim have been noted in the rejection of

claims 1, 8, 10, and 17. Applicant attention is directed to the rejection of claims 1, 8, 10, and 17

above. In addition, the combination of Howard et al. and Peltonen et al, as modified, discloses

the claimed limitations further comprising: a bus system; a communication unit connected to the

bus system; a memory connected to the bus system (See Howard et al. Fig.1 in which Howard et al. disclose that various components related to virtual directory system, Fig.2 wherein Howard et al. disclose a processing unit including a memory system and a network filesystem connected to a network storage that facilitated communication between them). Therefore, the claim is rejected in the same grounds for arguments given for the corresponding claims 1, 8, 10, and 17 above.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to modify the parallel virtual directory system of Howard et al. by incorporating the bookmark mechanism taught by Peltonen et al. because that would have enhanced the system of Howard et al. by allowing it to retrieve files or documents store in data store when a request to access to a file that they have selected from the virtual directory quickly and efficiently using the bookmark as a unique identifier and return the result appropriately in response to a request (See Peltonen et al. Abstract lines 14-19, col.8, lines 1-6).

As per claims 3, and 19, most of the limitations of these claims have been noted in the rejection of claims 1, and 17. Applicant attention is directed to the rejection of claims 1, 17 above. In addition, the combination of Howard et al. and Peltonen et al, as modified. discloses the claimed limitations, wherein the result is presented as a list of categories to a user (See Howard et al. col.7, lines 43-53, col.17, lines 25-30).

As per claims 4, and 20, most of the limitations of these claims have been noted in the rejection of claims 1, and 17. Applicant attention is directed to the rejection of claims 1, 17 above. In addition, the combination of Howard et al. and Peltonen et al, as modified, discloses the claimed limitations, wherein the locations of the file are in a remote data processing system

(See Howard et al. Abstract lines 4-5, col.2, lines 45-46).

As per claims 5, 14, and 21, most of the limitations of these claims have been noted in the rejection of claims 1, 10, and 17. Applicant attention is directed to the rejection of claims 1, 10, and 17 above. In addition, the combination of Howard et al. and Peltonen et al, as modified, discloses the claimed limitations, wherein input is a user input to save the file (See Howard et al. col.31, lines 18-23).

As per claims 6, 15, and 22, most of the limitations of these claims have been noted in the rejection of claims 1, 10, and 17. Applicant attention is directed to the rejection of claims 1, 10, and 17 above. In addition, the combination of Howard et al. and Peltonen et al, as modified, discloses the claimed limitations, wherein the input is from a program initiating saving of the file (See Howard et al. col.3, lines 64-66, col.31, lines 21-22).

As per claims 7, 16, and 23, most of the limitations of these claims have been noted in the rejection of claims 1, 10, and 17. Applicant attention is directed to the rejection of claims 1, 10, and 17 above. In addition, the combination of Howard et al. and Peltonen et al, as modified, discloses the claimed limitations, wherein the identifier is selected from one of a user name, an event, or a task (See Howard et al. col.4, lines 50-54, col.15, lines 18-23).

As per claim 24, most of the limitations of these claims have been noted in the rejection of claim 1. Applicant attention is directed to the rejection of claim 1 above. In addition, the combination of Howard et al. and Peltonen et al, as modified, discloses the claimed limitations,

wherein the data store contains a first file that is associated with a first item, wherein the data

store contains a second file that is associated with a second item, wherein the first item is the

same as the second item, and wherein the first file and the second file may be retrieved based on

the first item (See Howard et al. col. 18, lines 18-29, and lines 36-43; col.24, lines 32-48).

As per claim 25, the combination of Howard et al. and Peltonen et al, as modified,

discloses the claimed limitations, wherein the first file and the second file share a common

attribute (See Howard et al. col.24, lines 43-48).

Other Prior Art Made Of Record

11.   The prior art made of record and not relied upon is considered pertinent to Applicant's

disclosure. U.S. patents and U.S. patent application publications will not be supplied with Office

actions. Examiners advise the Applicant that the <u>cited</u> U.S. patents and patent application

publications are available for download via the Office's PAIR. As an alternate source, <u>all</u> U.S.

patents and patent application publications are available on the USPTO web site

(www.uspto.gov), from the Office of Public Records and from commercial sources. For the use

of the Office's PAIR system, Applicants may refer to the Electronic Business Center (EBC) at

http://www.uspto.gov/ebc/index.html or 1-866-217-9197

Conclusion

12.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jacques Veillard whose telephone number is (571) 272-4086.

The examiner can normally be reached on Mon. to Fri. from 9 AM to 4:30 PM, alt. Fri. off..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Chace Christian (571)272-4190. The fax phone number for the organization where

this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

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like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. V./

 Examiner, Art Unit 2165

/Neveen Abel-Jalil/

Primary Examiner, Art Unit 2165